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Response under 37 C.F.R. § 1.116
Expedited Procedure
Examining Group 2612
Patent
Attorney's Docket No. 032567-011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of) **MAIL STOP: AF**
Masahito NIIKAWA)
Application No.: 09/291,195) Group Art Unit: 2612
Filed: April 14, 1999) Examiner: James M. Hannett
For: IMAGE PROCESSING SYSTEM,) Confirmation No.: 1785
METHOD FOR FORMATTING)
RECORDING MEDIUM, AND)
PROGRAM PRODUCT)

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DEC 03 2003

Technology Center 2600

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a Request for Reconsideration for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☐ A Terminal Disclaimer and the ☐ \$55.00 (2814) ☐ \$110.00 (1814) fee due under 37 C.F.R. § 1.20(d) are also enclosed.
- ☐ Also enclosed is/are _____.
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$385.00 (2801) ☐ \$770.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
- ☐ Applicant(s) previously submitted ___, on ___, for which continued examination is requested.

- ☐ Applicant(s) requests suspension of action by the Office until at least __, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.
- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below:

| AMENDED CLAIMS | | | | | |
|------------------------------------------------------------------------------|---------------|-------------------------------------------|--------------|--------------------|-----------|
| | NO. OF CLAIMS | HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR | EXTRA CLAIMS | RATE | ADD'L FEE |
| Total Claims | 15 | MINUS 20 = | 0 | × \$18.00 (1202) = | 0 |
| Independent Claims | 6 | MINUS 6 = | 0 | × \$86.00 (1201) = | 0 |
| If Amendment adds multiple dependent claims, add \$290.00 (1203) | | | | | |
| Total Claim Amendment Fee | | | | | 0 |
| If small entity status is claimed, subtract 50% of Total Claim Amendment Fee | | | | | |
| TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT | | | | | 0 |

- ☐ A check in the amount of \$_____ is enclosed for the fee due.
- ☐ Charge \$_____ to Deposit Account No. 02-4800.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: December 1, 2003

By: John F. Guay
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BA 11/5/03

Response under 37 C.F.R. § 1.116
Expedited Procedure
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REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

In response to the final Office Action dated September 4, 2003, Applicant respectfully requests reconsideration and withdrawal of the rejections of the claims.

In the final Office Action, the Examiner maintained the rejection of claims 1, 3, 4, 6 and 8-10 as allegedly being anticipated by the Ueno et al. patent, the rejection of claims 2, 13 and 14 as allegedly being unpatentable over Ueno et al., the rejection claim 5 as allegedly being obvious over Ueno et al. in view of the Brief patent, and the rejection of claim 7 as allegedly being obvious over Ueno et al. in view of the Edwards et al. patent. The final Office Action states that the arguments presented by Applicant in the Amendment filed June 12, 2003, were not considered to be persuasive, for the following reasons:

The Action states that one of the features upon which Applicants relied in their arguments (starting at the middle of page 3 through the first full paragraph of page 4 of the Amendment), namely that the data transmitted from the host computer to the camera cannot reasonably be considered to be within the meaning of a "program," is not persuasive. The

Examiner's reasoning is based on a dictionary definition that defines a "program" as "a sequence of coded instructions that can be inserted into a mechanism (as a computer)." (See the final Office Action, page 2, lines 7-8.) The Examiner asserts that the disclosure in Ueno et al. of commands transmitted from the host computer "are viewed by the examiner as a sequence of coded instructions than can be inserted into a mechanism (as a computer)." (See the final Office Action, page 2, lines 9-11.) It is respectfully submitted, however, that one of ordinary skill in the art would not have interpreted "a program," as recited in claims 1, 6 and 10, to have the same meaning as the commands disclosed in the Ueno et al. patent.

The Microsoft Computer Dictionary, Fifth Edition, defines a "command" as "an instruction to a computer program that, when issued by the user, causes an action to be carried out" (emphasis added). This dictionary also defines a "program" as "a sequence of instructions that can be executed by a computer," which is similar to the definition provided by the Examiner.¹ It is respectfully submitted, however, that the disclosure of commands in the Ueno et al. patent does not fall within the latter definition of a program because the Ueno et al. patent does not disclose that when the camera 10 receives a command, it receives a "sequence" of coded instructions. Rather, Ueno et al. discloses that the camera 10 receives set-up data, transmission of controlled-variable transmission commands from the computer 30 (column 23, lines 15-18), and other commands, such as "shot" and "get," only after a user clicks an icon or enters a command via a keyboard. Furthermore, when these set-up data or commands are transmitted to the camera, the CPU 18 of the camera 10 causes processes programmed in the camera to be executed. These programs cause the camera 10 to transmit information back to the host computer 30. (See column 11, lines 49-53.) For instance, the shot command causes the electronic camera 10 to photograph a subject, process the image data, and transmit the image data to the host

¹ For the Examiner's convenience, Applicants provide herewith a copy of these definitions from Microsoft Computer Dictionary, Fifth Edition and a PTO Form 1449 listing these citations. Applicant respectfully requests that the Office initial the Form PTO 1449 and return a copy of the initialed form in the next communication with Applicant.

computer 30 (column 19, lines 26-29). The "get" command causes the image data obtained by photography in the electronic camera 10 to be accepted by the host computer 30 (column 19, lines 49-51.)

In contrast to the program recited in claim 1, the Ueno et al. patent does not disclose that the commands sent from the host computer 30 to the camera 10 include a sequence of instructions within any reasonable interpretation of the meaning of program. To the contrary, every time data is exchanged between the camera 10 and host computer 30, it is a result of a user initiated manipulation of an input device at the host computer 30 (e.g., "clicking" a representation on the display 40 using a mouse 37 and/or inputting signals by manipulating a computer keyboard 36). Data in these transmissions can include either a command, a request for a currently set camera parameter, or target camera parameters for the camera 10. (See column 13, lines 11-15 and 24-28.) The nature of the menu driven program executed at the host computer 30 allows the user to select from a variety of command options for causing the camera to perform some function. (See Figures 8-24.) However, regardless of the type of command selected by the user of the host computer 30, the resulting function performed in the camera is based on a program stored within the camera. (See column 13, lines 65-66.)

For instance, Figure 3 of the Ueno et al. patent shows a flowchart of the processing procedure in the host computer 30, and Figure 4 shows the processing procedure in the electric camera 10. (See column 13, lines 43-46.) As seen in Figure 4, one of commands 81, 83, 85 and 88 may be issued from the host computer 30 by a user. When the transmitted command is received by the camera 10, the camera performs one or more of the processes 82, 84, 86, 89, 90 in accordance with procedures resident in the camera (column 13, lines 62-66). For example, when a user wishes to set the parameters of the camera 10, the user clicks "Set-Up" on a menu displayed on the display unit 40 of the computer (see column 14, lines 43-44, lines 57-58 and lines 66-67). The user sets the value of the parameter and sends it to the camera 10 (see item 93 fo Figure 5). As shown in Figure 7, if the set-up data sent by the host computer 30 indicates a remote setting of a controlled variable, the camera 10 responds by sending the current value stored in the

camera controlled-variable memory 17C to the computer 30 (e.g., see column 16, lines 35-40 and column 17, lines 28-33). If the user wishes to adjust the value from the returned value, the user sets a value at the computer and transmits a target value to the camera 10 (e.g., see column 16, lines 51-67 and column 17, lines 2-4 and lines 41-54).

When the camera 10 responds to each command from the host computer 30, the camera carries out the process of the remote function of the camera called for by the command. The program executed within the camera 10, when conforming to set-up data sent from the host computer 30, is shown in greater detail of the program flow chart of Figure 26, and described in column 22, line 33 to column 24, line 51. As shown in the process flow of Figure 26 of Ueno et al., the camera 10 executes a program stored in the camera to according to a previously received command and then simply waits for the next command. (See Figure 26, process 138.)

Hence, the Ueno et al. patent does not mention or imply that a sequence of instructions is transmitted in the context of a program, as claimed, because the commands, set-up data etc. appear to be sent to the camera 10 only after a user initiates such an event (e.g., clicking a representation of a command on the display 40). Moreover, Ueno does not either explicitly or inherently disclose that any one command includes a “sequences of instructions” which one of ordinary skill in the art would have interpreted be within the meaning of the claimed program as claimed. In fact, commands are not sent in sequence, they are sent individually, because each command requires a response from the camera before the next command is sent.

As instructed in MPEP §2111.01: “the words of a claim must be given their plain meaning. In other words, they must be read as they would be interpreted by those of ordinary skill in the art.” For at least the above reasons, Applicant respectfully submits that the Examiner’s interpretation of “commands,” as disclosed in the Ueno et al. patent, is neither consistent with the applied dictionary definition of “program” nor the interpretation that one of ordinary skill in the art would give the claimed term “program.”

In any event, regardless of whether one of ordinary skill in the art would have interpreted a command to be a program, the Amendment included arguments that the Ueno

et al. patent does not disclose the claimed features of an image processing apparatus comprising a processor for creating a region accessible from a photographing apparatus, and a controller for causing a program executed by the photographing apparatus to be stored in the region. Specifically, pages 4 to 5 of the response included the following statements:

It is respectfully submitted that the *Ueno* patent also fails to disclose a combination that includes, *inter alia*, a processor for creating a region accessible from the photographing apparatus, and a controller for causing the program to be stored in the region, as recited in claim 1. In the context in which "a region accessible ..." is claimed, the photographing apparatus is capable of gaining entry to the region in which the program is stored in order to read data from the region. In contrast, the *Ueno* patent does not mention any region in which a program is stored by a controller of a processing apparatus that could be reasonably be considered accessible from the photographing apparatus. To the contrary, in the system described in the *Ueno* patent, control of where data is stored or read from (i.e., the main memory 32 or the optical disk unit 38) is determined from the computer side. (See the *Ueno* patent, column 14, lines 57-62; column 19, lines 56-67; column 20, lines 36-40; and column 22, lines 1-15.) The *Ueno* patent does not, in fact, disclose that the camera 10 can access a region created by an image processing apparatus.

Applicant disputes any allegation that the *Ueno* patent discloses that "the region accessible to the camera is the region of the memory (32) that transfers information to and from the camera" (See the Office Action, page 2, the last line to page 3, line 2.) First of all, the memory 32 of the *Ueno* patent does not transfer information because this task is carried out by the host computer's processor (i.e., CPU 31). (See the *Ueno* patent, column 13, lines 11-20.) Second, claim 1 does not recite "a region accessible to the camera," as alleged by the Examiner. Rather, claim 1 recites "a region accessible from the photographing apparatus." It is respectfully submitted that the *Ueno* patent fails to disclose these claimed features. (Emphasis in original.)

The Examiner, however, did not consider these statements to be convincing, for the following reasons:

The applicant acknowledges that in the system described in the *Ueno* patent, control of where data is stored or read from is determined from the computer side. It is viewed by the examiner and should be noted by applicant that for examination purposes the Examiner has viewed the image processing apparatus as being the computer as taught in *Ueno et al.*

(See the final Office Action, page 2.) The undersigned does not understand these statements of the final Office Action because they do not appear related to the claimed processor for creating a region accessible from the photographing apparatus and a controller for storing a program in this region as set forth in claim 1.

Applicant's response also pointed out several instances of claimed subject matter recited in claims 6 and 10 that are not disclosed in the Ueno et al. patent. For instance, on page 6 of the Amendment, Applicant argued that the Ueno et al. patent failed to disclose the features of claim 6 pertaining to a photographing apparatus including "an interface for reading a program for processing the image data recorded in said memory out of an external recording medium" and "a controller for executing the program read out from the external recording medium." The statements in the "Response to Arguments" section of the final Office Action, however, do not address these points raised in the Amendment. Applicant respectfully reiterates that the Ueno et al. patent does not disclose that the camera 10 includes an interface for reading a program and a controller for executing the read program as claimed.

With respect to claim 10, Applicant argued, at page 6 of the Amendment, that the Ueno et al. patent does not anticipate claim 10 because it recites subject matter similar to that recited in claim 1. For instance, Applicant argued that the Ueno et al. patent does not disclose an image processing system that includes the claimed photographing apparatus comprising a controller for executing a program recorded in the recording medium connected to said image processing apparatus. For the reasons given above with respect to claim 1, Applicants respectfully submit that any reasonable interpretation of the term "command," as used in the Ueno et al. patent, would not have disclose these features recited in claim 10. As discussed above, Ueno et al. does not disclose a photographing apparatus that includes a controller for executing a program recorded in a recording medium connected to an image processing apparatus because each command sent by the host computer 30 instructs the camera 10 to execute programs which appear resident in the camera.

The statements in the "Response to Argument" section also do not address the arguments in the Amendment concerning the rejection of claim 10. For instance, Applicant argued that column 13, lines 10-30 of the Ueno et al. patent cited by the Examiner does not disclose the claimed image processing apparatus comprising a processor for creating a task region in the recording medium, and that Ueno et al. does not disclose the task region is temporarily used to execute the program. The Examiner's statements on page 2 of the final Office Action, however, do not address these arguments. Moreover, Applicants submit the Ueno et al. patent does not disclose the claimed task region. As discussed above, any processes that involve programs executed by the camera 10 of Ueno et al. appear to originate from the camera 10.

If the Examiner maintains the rejection of these claims, it is respectfully requested that the Examiner provide further clarification as to the specific parts of the Ueno et al. patent relied upon for disclosing these features.

For at least the above reasons, and for those set forth in the July 12, 2003 Amendment, Applicant respectfully submits that the combination of features recited in claims 1, 6 and 10, and hence also in their respective dependent claims, define patentable subject matter not disclosed in the Ueno et al. patent. The rejection is therefore believed improper and should be withdrawn.

With respect to dependent claim 4, Applicant's argued that the portion of the Ueno et al. patent cited in the first Office Action fails to disclose the claimed features of "if said photographing apparatus is reconnected to said image processing apparatus after disconnection, a reconnecting process is performed using data stored in a buffer memory of an interface in the photographing apparatus." (See the Amendment, pages 6 to 7.) The Examiner did not find these arguments convincing, based on the following statements:

On Column 18, lines 38-53 [sic] Ueno states that camera control data in the set-up mode is stored in the camera control-parameter memory and in the reception buffer (17D) in the camera. Ueno further states that camera adjustment is performed based in the data in this memory. The examiner notes that a reconnection process is viewed as the process for set-up mode.

It is respectfully submitted, however, that the set-up mode described in the Ueno et al. patent is not the same as the claimed condition "if said photographing apparatus is reconnected to said image processing apparatus after disconnection, a reconnecting process is performed using data stored in a buffer memory of an interface in the photographing apparatus." By contrast, the "set-up mode" described in Ueno et al. involves setting one or more camera parameters while the camera 10 is connected to the host computer 30. (See the detailed description of set-up in column 14, line 66 to column 18, line 37.) There is simply no disclosure in the cited portion of Ueno et al. concerning reconnection after disconnection, and a reconnecting process being performed using data stored in a buffer memory. Hence, in addition to being allowable at least for the reasons given above for parent claim 1, dependent claim 4 recites a combination including additional features not disclosed in the Ueno et al. patent.

Turning now to the rejection of claims 2, 13 and 14 under Section 103, the statements in the "Response to Arguments" section assert that several features upon which Applicant relied in his arguments are allegedly not recited in claims. (See the final Office Action, page 3, lines 9-10.) The Examiner also alleged that claims 13 and 14 simply specify a first region for storing a first program, a second region for storing a second program, and a third region. (See the final Office Action, page 3, lines 11-12.) Applicant disagrees with these statements for reasons pointed out in the Amendment concerning specific features not taught in the applied prior art. For instance, Applicant argued why the proposed combination of the Ueno et al. patent and the relied alleged knowledge in the art fail to teach or suggest the step of *creating a first region for storing a first program in the recording medium, wherein the first program is to be executed by a photographing apparatus*, as recited in claim 13, and *a first region for storing a first program to be created in a recording medium provided in the computer, the first program being executed by a photographing apparatus*, as recited in claim 14. (See the Amendment, page 9, line 15 to page 10, line 5.) The response also pointed out that, in addition to not teaching or suggesting all the claimed features, the modifications to the Ueno et al. system proposed by

the Examiner would not have been obvious because they would have changed the principle operation of that reference. (*Id.*, page 10, lines 6-19.)

Applicants response further included detailed arguments directed to why the claims would not have been obvious over the Ueno et al. patent. For instance, Applicant pointed out why the problems Ueno et al. attempts to address are different from the problems addressed by the present invention. (See the Amendment, page 7, line 15 to page 9, line 14.)² These arguments also explained why Applicant disagreed with the Examiner's allegations that the Ueno et al. patent teaches a camera "comprising a controller (18) for executing a program recorded in the recording medium (32) connected to the image processing apparatus (30)." (See the Office Action, page 5, lines 17-18; and page 6, lines 5-6.)³ The statements of the "Response to Arguments" section, however, do not address these points of distinction that were brought out by Applicants.

Hence, applicant presented several arguments directed to the specific combination of features recited in each of claims 13 and 14, and why the proposed combination does not teach or suggest these features. The statements in the "Response to Arguments" section of the final Office Action, however, do not address these specific points raised in the Amendment.

Claims 2, 3, 5 and 7-9 depend from one of claims 1 and 6, and thus are not anticipated by the Ueno et al. patent for at least the above reasons. Furthermore, these dependent claims recite combinations that include additional features that are not taught or suggested in the Ueno et al., patent, whether taken individually or in any combination with the Brief patent and the Edwards et al. patent. In view of the foregoing, however, a

² MPEP §2141.02 states that such differences are part of the "subject matter as a whole" which should always be considered in determining the obviousness of an invention under Section 103.

³ This point was made in response to an allegation made by the Examiner in the March 17, 2003 Office Action, which is also present in the final Office Action, at page 8, lines 17-18.

discussion of those additional distinctions are believed to be unnecessary at this time. Applicant notes, however, that further distinctions exist therein.

Applicant appreciates the continued indication of allowable subject matter for claims 11 and 12. However, for the foregoing reasons, it is respectfully submitted that pending claims 1-10, 13 and 14 also are patentable over the disclosure of the Ueno et al. patent, whether taken alone or in any combination with the alleged common knowledge in the art, the Brief patent and the Edwards et al. patent. If the rejection of any of the claims is maintained, Applicant requests that the Examiner identify how the Ueno et al. patent is being interpreted to suggest the specific distinguishing features discussed above. In the absence of such a showing, it is respectfully submitted that the rejections should be withdrawn.

The Noonan et al. Patent Does Not Disclose All Recited Features of Claim 15

The final Office Action also includes a rejection of claim 15 under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 5,926,208 to Noonan et al. (hereinafter, "Noonan et al."). This rejection is respectfully traversed.

Claim 15 is directed to a method of formatting a recording medium in an image processing system including a computer and a photographing apparatus connectable to the computer, the computer being connectable to the recording medium and the recording medium storing a program executable by the photographic apparatus. It is respectfully submitted that claim 15 recites a combination of features not disclosed in the Noonan et al. patent. These differences between are pointed out in the following analysis of this document and claim 15.

Claim 15 first recites creating a first region in the recording medium and storing in the first region a program dedicated for execution by the photographing apparatus. In connection with this claimed subject matter, the final Office Action, at page 6, asserts that disclosure in the Noonan et al. patent of a region in the computer (i.e., computer 1002) storing a compression module (i.e., one of the MPEG, MPEG1, MPEG2, JPEG, H.320, and H.324 compression modules disclosed in column 4, lines 33-34) meets the feature of

creating a first region in the recording medium and storing in the first region a program (i.e., one of the compression module) dedicated for execution by the camera (i.e., video camera 1000).

The next recited features of claim 15 include creating a second region in the recording medium, storing in the second region a second program for execution by the photographing apparatus. With respect to these features, the Action asserts that a second one of the compression modules disclosed in Noonan et al. is stored in a second region in the recording medium (i.e., the region in the computer 1002).

Next, the procedure recited in claim 15 creates a third region in the recording medium which is temporarily used as a task region during execution of the program by the photographing apparatus. The final Office Action asserts that the recited third memory region corresponds to the memory stack described in column 8, lines 1-15 in Noonan et al.

The memory stack described in the cited portion of Noonan et al., however, pertains to the stack contained in the external SRAM 152 of the video camera that is accessible by the video communication processor 1024 (see Figure 2, 2a and 3, and column 7, line 66 to column 8, line 14). As such, the SRAM 152 is not the same recording medium as the medium in the computer, which the Examiner alleged has created therein the first and second regions. Hence, the alleged third region containing the SRAM is not in the recording medium as claimed. Therefore, the Noonan et al. patent does not teach the combination of features including, *inter alia*, creating a third region in the recording medium which is temporarily used as a task region during execution of the program by the photographing apparatus, as recited in claim 15.

For at least these reasons the rejection improper and should be withdrawn.

Withdrawal of the all rejections and immediate allowance of all pending claims are earnestly solicited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: _____


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Date: December 1, 2003